

This Opinion is not a
Precedent of the TTAB

Mailed: September 29, 2021

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board

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In re Vans, Inc.

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Serial No. 88677016

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Kaitlyn Garvin of Saunders & Silverstein LLP,
for Vans, Inc.

Samantha Sherman, Trademark Examining Attorney, Law Office 123,
Susan Hayash, Managing Attorney.

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Before Bergsman, Kuczma and Pologeorgis,
Administrative Trademark Judges.

Opinion by Kuczma, Administrative Trademark Judge:

Vans, Inc. (“Applicant”) seeks registration on the Principal Register of the mark
THE ORIGINAL CHECKERBOARD CO. ESTABLISHED SINCE SIXTY-SIX (in
standard characters) for:

Belts; Bottoms as clothing; Footwear; Headwear; Jackets;
Pants; Shirts; Shorts; Socks; Sweat Pants; Sweat Shirts;
Tops as clothing, in International Class 25.¹

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¹ Application Serial No. 88677016 was filed on November 1, 2019, originally based upon Applicant’s assertion of a bona fide intention to use the mark in commerce under Section 1(b) of the Trademark Act, 15 U.S.C. § 1051(b). Applicant subsequently submitted an amendment to allege use on May 13 2020, claiming first use anywhere at least as early as August 29,

The Trademark Examining Attorney refused registration of Applicant's mark under Section 2(e)(1) of the Trademark Act, 15 U.S.C. § 1052(e)(1), on the ground that Applicant's applied-for mark is merely descriptive of the identified goods.

When the Examining Attorney made the refusal final, Applicant appealed and requested reconsideration, including, in the alternative, registration on the Supplemental Register. After the Examining Attorney denied the request for reconsideration, the appeal was resumed and fully briefed, including Applicant's reply brief. For the reasons set forth below, the refusal to register is affirmed.

I. Descriptiveness Under Section 2(e)(1)

In the absence of acquired distinctiveness, Section 2(e)(1) of the Trademark Act precludes registration of a mark on the Principal Register that, when used in connection with an applicant's goods, is merely descriptive of them. 15 U.S.C. § 1052(e)(1). "A mark is merely descriptive if it immediately conveys information concerning a feature, quality, or characteristic of the goods or services for which registration is sought." *Real Foods Pty Ltd. v. Frito-Lay N. Am., Inc.*, 906 F.3d 965, 128 USPQ2d 1370, 1373 (Fed. Cir. 2018) (quoting *In re N.C. Lottery*, 866 F.3d 1363, 123 USPQ2d 1707, 1709 (Fed. Cir. 2017)).

2019 and first use in commerce since at least as early as January 20, 2020, under Section 1(a) of the Trademark Act, 15 U.S.C. § 1051(a).

Page references to the application record refer to the online database of the USPTO's Trademark Status & Document Retrieval (TSDR) system in downloadable .pdf format. References to the briefs on appeal refer to the Board's TTABVUE docket system where the first number is the docket entry and the second number is the page within the entry.

Determining the descriptiveness of a mark under Section 2(e)(1) of the Trademark Act, 15 U.S.C. § 1052(e)(1), is not considered in the abstract. Rather, it is considered in relation to an applicant's goods for which registration is sought, the context in which the mark is being used, and the possible significance the term would have to the average purchaser of the goods because of the manner of its use or intended use. *See In re The Chamber of Commerce of the U.S.*, 675 F.3d 1297, 102 USPQ2d 1217, 1219 (Fed. Cir. 2012) (citing *In re Bayer Aktiengesellschaft*, 488 F.3d 960, 82 USPQ2d 1828, 1831 (Fed. Cir. 2007)).

For a term to be merely descriptive within the meaning of § 2(e)(1), it is not necessary that the term describe each feature of the goods, only that it conveys a single, significant ingredient, quality, characteristic, feature, function, purpose or use of the goods with which it is used. *See, e.g., In re TriVita, Inc.*, 783 F.3d 872, 114 USPQ2d 1574, 1575 (Fed. Cir. 2015) (quoting *In re Oppedahl & Larson LLP*, 373 F.3d 1171, 71 USPQ2d 1370, 1371 (Fed. Cir. 2004)); *In re Chamber of Commerce*, 102 USPQ2d at 1219; *In re Gyulay*, 820 F.2d 1216, 3 USPQ2d 1009, 1009 (Fed. Cir. 1987).

Marks comprising more than one element, like Applicant's mark, must be considered as a whole and should not be dissected; however, we may consider the significance of each element separately in the course of evaluating the mark as a whole. *See DuoProSS Meditech Corp. v. Inviro Med. Devices, Ltd.*, 695 F.3d 1247, 103 USPQ2d 1753, 1757 (Fed. Cir. 2012); *In re Oppedahl & Larson*, 71 USPQ2d at 1372 ("PTO may properly consider the meaning of 'patents' and the meaning of '.com' with respect to the goods identified in the application. However, if those two portions

individually are merely descriptive of an aspect of appellant's goods, the PTO must also determine whether the mark as a whole, i.e., the combination of the individual parts, conveys any distinctive source-identifying impression contrary to the descriptiveness of the individual parts"). Thus, we begin by looking at the meaning of the components of Applicant's applied-for mark.

Looking at the first word in the beginning of Applicant's applied-for mark, the definite article "THE" is not distinctive and adds no source-indicating significance to the applied-for mark as a whole; and Applicant does not contend otherwise. *See In re The Place Inc.*, 76 USPQ2d 1467, 1468 (TTAB 2005) ("the definite article THE . . . add[s] no source-indicating significance to the mark [THE GREATEST BAR] as a whole"); *Conde Nast Publications Inc. v. Redbook Publishing Co.*, 217 USPQ 356, 357, 360 (TTAB 1983) ("[t]he fact that the slogan [THE MAGAZINE FOR YOUNG WOMEN] also includes the article 'The' is insignificant. This word cannot serve as an indication of origin, even if applicant's magazine were the only magazine for young women."); *In re The Computer Store, Inc.*, 211 USPQ 72, 74-75 (TTAB 1981) (holding THE COMPUTER STORE merely descriptive of, and the common descriptive name for, computer-related services).

Moving to the second term, "ORIGINAL" is defined as "not derived from something else; fresh and unusual . . ." ² The Board has held "that the word 'original' used alone or paired with descriptive wording is merely laudatory and descriptive of

² *See* January 13, 2020 Office Action at TSDR 7, The American Heritage Dictionary, www.ahdictionary.com/word/search.html?q=original.

goods being the first of their kind.” See *In re Ervin*, 1 USPQ2d 1665, 1666 (TTAB 1986) (holding THE “ORIGINAL” merely laudatory and descriptive of applicant’s scorer for playing euchre as the first of its kind); *Gen. Foods Corp. v. Ralston Purina Co.*, 220 USPQ 990, 994 (TTAB 1984) (holding ORIGINAL BLEND merely laudatory and descriptive of applicant’s cat food comprising a first-of-its-kind combination of ingredients).³ “Marks that are merely laudatory and descriptive of the alleged merit of a product are . . . regarded as being descriptive” because “[s]elf-laudatory or puffing marks are regarded as a condensed form of describing the character or quality of the goods.” *DuoProSS Meditech v. Inviro Med. Devices*, 103 USPQ2d at 1759 (quoting *In re The Bos. Beer Co.*, 198 F.3d 1370, 53 USPQ2d 1056, 1058 (Fed. Cir. 1999)); see also *Gen. Foods v. Ralston Purina*, 220 USPQ 990.

Additionally, the Examining Attorney submitted Internet excerpts showing third-party use of the term “ORIGINAL” to advertise or describe clothing goods similar to those of Applicant:

Rockstar Original® (offering jackets, jeans and t-shirts).⁴

Kohl’s – Mens Levi’s® 501® – “Original Clothing.”⁵

HAVEN Children – “Sustainable, socially responsible, and original clothing for kids.”⁶

In response, Applicant made of record Principal Register registrations for marks that include the term “ORIGINAL” which was not disclaimed or registered under

³ Examining Attorney’s Brief, 10 TTABVUE 6-7.

⁴ See January 13, 2020 Office Action at TSDR 9-13.

⁵ *Id.* at TSDR 14-18.

⁶ *Id.* at TSDR 19-22.

§ 2(f). We only find the following three registrations to be probative since they involve clothing items and services related to Applicant’s goods⁷:

Mark	Registration No.	Goods/Services
 TEXAS AND SINCE 1965 disclaimed	3449196	Retail stores featuring western clothing, boots, hats, and accessories in Class 35
ORIGINAL GANGSTER GEAR GEAR disclaimed	3214076	Clothing, namely, shoes, jackets, t-shirts, hats, sleepers, namely, long shirts and panties in Class 25
THE ORIGINAL MADE IN AMERICA STORE MADE IN AMERICA and	4584657	Clothing, namely, t-shirts in Class 25

⁷ See December 8, 2020 Request for Reconsideration, Exhibit A at TSDR 70-76. The following registrations are not probative since they cover unrelated goods and services and were not considered: Registration Nos. 5819963 for OINK THE ORIGINAL SINGING PIG (SINGING PIG disclaimed) for a comedy performing pig show; 3003616 for THE ORIGINAL LIVING STATUES (LIVING STATUES disclaimed) for videos and live performances performed by costumed street performers; 5520036 for THE ORIGINAL BED & BREAKFAST COLLECTION (COLLECTION disclaimed) for buying club and related services; 3221409 for



(PEANUT DRYING SEMI TRAILER disclaimed) for peanut semi trailers; 3934732 for THE ORIGINAL JERSEY BOYS for providing live concerts; 3098762 for MADE BY THE ORIGINAL TOBACCO TRADERS for cigarettes; and 4074613 for ORIGINAL 1853 CHIPS (CHIPS disclaimed) for frozen processed vegetables

Additionally, Registration Nos. 3156626 for THE ORIGINAL SEX SYMBOL; 3141996 for www.Geek-Guy.com The Original Geek Toy Store & Design, STORE disclaimed; and 2925109 for meta.com mor pix the original photo mix, PHOTO disclaimed, were also included in Exhibit A but are cancelled and have not been considered. It is well-established that an expired or cancelled registration is only evidence that the registration issued and it does not carry any of the legal presumptions under Section 7(b) of the Trademark Act, 15 U.S.C. § 1057(b). *In re Info. Builders, Inc.*, 2020 USPQ2d 10444, at *6 n.19 (TTAB 2020).

Mark	Registration No.	Goods/Services
STORE disclaimed		

Applicant notes that the registered marks having the structure “THE ORIGINAL [noun]” (and “ORIGINAL [noun]”) were registered even when the inserted noun is arguably descriptive of the relevant goods or services. However, the non-descriptive portion of its applied for mark, i.e., “THE ORIGINAL CHECKERBOARD CO.,” according to Applicant, takes the standard convention of “THE ORIGINAL (descriptive term)” “and turns it on its head by successfully swapping out an ordinary descriptive term for a term that instead powerfully suggests a connection between its goods and the high-adrenaline world of action sports. . . . [Applicant] chose a much stronger identifier that references underlying concepts that are deep at the heart of Applicant’s brand identity.”⁸ Inasmuch as only two of the registered marks for clothing include a descriptive noun, and there is no evidence supporting Applicant’s assertion that “THE ORIGINAL CHECKERBOARD” suggests a connection between its goods and the “high adrenaline world of action sports,” the third-party registrations cited by Applicant offer it little support.

Applicant also contends that “ORIGINAL’ cannot be considered descriptive of Applicant’s goods because, in context, i[t] clearly modifies the word ‘CO.,’” conveying to consumers that Applicant is the first brand to build its identity around the “unique

⁸ Applicant’s Appeal Brief, 8 TTABVUE 10.

symbolism of the Checkerboard.”⁹ Applicant’s unsubstantiated statement without more, is not sufficient for us to find that “ORIGINAL” modifies “CO.” In any event, whether “ORIGINAL” is used alone or paired with descriptive wording like “CO.” (addressed *infra*), it is merely descriptive of goods that Applicant represents are the first of their kind.

As to the term “CHECKERBOARD,” it “merely describes the pattern of Applicant’s goods” as supported by the definition of “CHECKERBOARD” which is defined as “a pattern resembling the alternating squares” of “a board on which chess and checkers are played, divided into 64 squares of two alternating colors;”¹⁰ “2: something that has a pattern or arrangement like a checkerboard.”¹¹

The Examining Attorney submitted Internet excerpts showing use of the term “checkerboard” by third parties in advertising that describes clothing goods similar to those of Applicant (emphasis below added):

Michael Kors® – “Keaton **Checkerboard** Logo Leather Slip-On Sneaker”; “Crafted from leather and updated in a **checkerboard** print with ‘KORS’ lettering, our Keaton slip-on sneakers are an instant favorite for off-duty ensembles.”¹²

Topshop® – “**Checkerboard** Love Print Trousers”; “Channel a modern look with our high waisted stand out

⁹ Applicant’s Appeal Brief, 8 TSDR 5.

¹⁰ January 13, 2020 Office Action at TSDR 23, The American Heritage Dictionary, www.ahdictionary.com/word/search.html?q=checkerboard, Copyright 2020 Houghton Mifflin Harcourt.

¹¹ The Board may take judicial notice of dictionary definitions. *See In re Cordua Rests. LP*, 110 USPQ2d 1227, 1229 n.4 (TTAB 2014) *aff’d*, 823 F.3d 594, 118 USPQ2d 1632 (Fed. Cir. 2016). *See* Merriam-Webster dictionary; merriam-webster.com/dictionary/checkerboard, 9/28/2021.

¹² *See* January 13, 2020 Office Action at TSDR 25-34.

combat trousers featuring all over love **checkerboard** print.”¹³

H&M® – “**Checkerboard** Shirt”; “Straight-cut shirt in woven cotton fabric with a printed **checkerboard** pattern.”¹⁴

Zazzle® - “**Checkerboard** Clothing & Shoes.”¹⁵

AXCID Shop – “**Checkerboard** Collection;” “**Checkerboard** Clothing;” “**Checkerboard** clothing is so trendy these days; “Versatile and easy-to-wear, impress your best babes with these uber cool **checkerboard** clothing pieces;” “The **checkerboard** clothing items are perfect for girls who adore the attention, who doesn’t?;” “Try out a **checkerboard** top and accessorize with our hottest jewelry to achieve that high-fashion street style.”¹⁶

Ben Sherman® – “Long-Sleeve Dash Dot **Checkerboard** Shirt – Black;” “With a classic-fit silhouette, a textured dash-dot **checkerboard** pattern, and premium cotton materials, this men’s long-sleeved shirt is a great addition to any wardrobe.”¹⁷

Jungmaven® – “**Checkerboard** Venice Short;” “Retro **checkerboard** print on our retro Op-style Venice Shorts.”¹⁸

Dannijo® – “**Checkerboard** Hoodie.”¹⁹

Nordstrom Rack® – Theory® – “Rammy **Checkerboard** Shirt”; “The **checkerboard** button-down that every closet

¹³ *Id.* at TSDR 35-37.

¹⁴ *Id.* at TSDR 38-42.

¹⁵ *See* February 2, 2021 Request for Reconsideration Denied at TSDR 57-65.

¹⁶ *Id.* at TSDR 66-70.

¹⁷ *Id.* at TSDR 71-72.

¹⁸ *Id.* at TSDR 73-75.

¹⁹ *Id.* at TSDR 91-94.

needs for a polished and effortless casual style;” “Allover **checkerboard** print.”²⁰

ASOS® – ASOS DESIGN® “dress in **checkerboard**.”²¹

Madewell® – “Flannel Courier Shirt in **Checkerboard**;”
“We remade our perfectly oversized, slightly boxy shirt in a bold navy **checkerboard**-print flannel.”²²

Escada® – “Sequin **Checkerboard** Dress”; “Our seasonal **checkerboard** motif gets a glamorous twist in this sparkly sequin dress.”²³

Bugatchi® – “Long Sleeve **Checkerboard** Check Cotton Shirt.”²⁴

Additionally, the Examining Attorney submitted copies of Internet articles published in Gear Patrol, in an article entitled “Our Favorite Brands Are Using This Unexpected Pattern,” and New York Magazine, in an article entitled “I Suddenly Want to Cover My Body (and My Home) in Checkerboard,” mentioning Applicant’s “checkerboard” pattern on socks and shoes.²⁵

²⁰ *Id.* at TSDR 111-114.

²¹ *Id.* at TSDR 115-117.

²² *Id.* at TSDR 118-122.

²³ *Id.* at TSDR 123-126.

²⁴ *Id.* at TSDR 127-129.

²⁵ See February 2, 2021 Request for Reconsideration Denied, Gear Patrol, www.gearpatrol.com/style/a696602/checkerboard-style-trend/ at TSDR 76-88 (“From sneakers to shirts, sweaters and accessories, the pattern follows in the footsteps of the recent animal-print trend. Perhaps the most well-known example is Sean Penn’s character Spicoli in the ‘80s teen movie *Fast Times at Ridgemont High*. His stoner character sported the now-iconic Vans slip-on in a **checkerboard** print, which trendy youth had previously been DIY-ing with permanent markers.”).

New York Magazine, nymag.com/strategist/article/checkerboard-print-trend.html at TSDR 95-106 (“a pair of black-and-white **checkerboard**-print socks – which I decided not to purchase because I just didn’t want to spend \$26 on socks – stood out to me. I kind of forgot about them until a few weeks later, when a friend posted a photo of herself wearing those exact same socks paired with **checkerboard** slip-on Vans on Instagram. . . . It’s not a new

Based on the evidence submitted, “checkerboard” is a descriptive term used to describe a common fabric pattern design which is used on some of Applicant’s goods.²⁶

Turning to the term “CO.,” it designates Applicant’s entity or business type.²⁷ Usually, business type designations and abbreviations such as “Corporation,” “Inc.,” “Company,” “Co.,” “LLC,” and “Ltd.” must be disclaimed in marks seeking registration on the Principal Register under §2(f) or on the Supplemental Register because they merely indicate an applicant’s business type or structure and generally have no source-indicating capacity. *See, e.g., Goodyear’s India Rubber Glove Mfg. Co. v. Goodyear Rubber Co.*, 128 U.S. 598, 602-03 (1888) (the addition of the word “Company” only indicates that parties have formed an association or partnership to deal in such goods, either to produce or to sell them); *In re Piano Factory Grp., Inc.*, 85USPQ2d 1522, 1526 (TTAB 2006); *In re Patent & Trademark Servs., Inc.*, 49 USPQ2d 1537, 1539-40 (TTAB 1998); TRADEMARK MANUAL OF EXAMINING PROCEDURE § 1213.03(d) (July 2021). There is nothing that changes the meaning of the business designation “CO.” as used in Applicant’s applied-for mark; indeed, the explanatory

trend. Anyone who’s seen Fast Times at Ridgemont High (circa 1982) will remember Sean Penn’s character’s **black-and-white checked** Vans. . . . Includes a photograph of and link to purchase Applicant’s **checkerboard** print ‘Classics’ shoes with the caption ‘And just because we wouldn’t be here without them.’”). (emphasis added).

²⁶ See Applicant’s specimen at TSDR 1-21.

²⁷ In response to the Examining Attorney’s request at 10 TTABVUE 11, we take judicial notice of the definition of “Co.” from Merriam-Webster Online Dictionary (www.merriam-webster.com/dictionary/company) attached at 10 TTABVUE 33, which establishes that “Co.” is an abbreviation for “Company” defined as “an association of persons carrying on a commercial or industrial enterprise.” *In re Jimmy Moore LLC*, 119 USPQ2d 1764, 1768 (TTAB 2016) (taking judicial notice of definitions from Merriam-Webster Online Dictionary at www.merriam-webster.com).

phrase following “CO.,” i.e., “ESTABLISHED SINCE SIXTY-SIX,” reaffirms that “CO.” is used as a business designation in Applicant’s mark and must be disclaimed.

With respect to the remaining portion of its mark, “ESTABLISHED SINCE SIXTY-SIX,” Applicant concedes the common, descriptive nature of that phrase as applied to its clothing, footwear and headwear by agreeing to disclaim it.²⁸ The disclaimer of a term constitutes an admission of the merely descriptive nature of that term, as applied to the goods or services in connection with which it is registered, and an acknowledgment of the lack of an exclusive right therein at the time of the disclaimer. *See In re DNI Holdings Ltd.*, 77 USPQ2d 1435, 1442 (TTAB 2005); *In re JM Originals*, 6 USPQ2d 1393, 1394 (TTAB 1987) (citing *Quaker State Oil Refining Corp. v. Quaker Oil Corp.*, 453 F.2d 1296, 172 USPQ 361, 363 (CCPA 1972), *aff’g* 161 USPQ 547, 549 (TTAB 1969)). As explained by the Examining Attorney, the phrase “ESTABLISHED SINCE SIXTY-SIX” merely conveys that Applicant’s business began in the year 1966.²⁹ This phrase is commonly used in business to indicate when a company was founded or otherwise began operating; thus, it is merely informational about the goods and does not function as a mark when used in that sense. *In re Bos. Beer*, 53 USPQ2d at 1058-59; *In re Eagle Crest, Inc.*, 96 USPQ 1227, 1229 (TTAB 2010); *In re Aerospace Optics, Inc.*, 78 USPQ2d 1861, 1864 (TTAB 2006).

While conceding that the “ESTABLISHED SINCE SIXTY-SIX” portion of its mark is descriptive, Applicant contends that “THE ORIGINAL CHECKERBOARD CO.”

²⁸ Applicant’s Appeal Brief at 8 TTABVUE 4; Applicant’s Reply Brief at 11 TTABVUE 5.

²⁹ *See* January 13, 2020 Office Action at TSDR 51.

does not convey qualities or characteristics of Applicant's clothing goods to consumers, but rather it is a playfully suggestive unitary phrase that consumers will perceive as referring to Applicant's "specific and distinct brand identity" involving the "thrills and excitement associated with action sports and skate culture."³⁰

A mark is suggestive if some imagination, thought, or perception is needed to understand the nature of the goods and/or services described in the mark; whereas a descriptive term immediately and directly conveys some information about the goods and/or services. *See Stoncor Grp., Inc. v. Specialty Coatings, Inc.*, 759 F.3d 1327, 111 USPQ2d 1649, 1652 (Fed. Cir. 2014) (citing *DuoProSS Meditech v. Inviro Med. Devices*, 103 USPQ2d at 1755). While a mark comprising a combination of merely descriptive components is registrable if the composite creates a unitary mark with a separate, nondescriptive meaning as applied to the goods or services, *see In re Colonial Stores Inc.*, 394 F.2d 549, 157 USPQ 382 (CCPA 1968); *In re Shutts*, 217 USPQ 363 (TTAB 1983), if the individual components of a mark retain their descriptive meaning in relation to the goods, the combination results in a composite mark that is itself descriptive and not registrable. *In re Oppedahl & Larson*, 71 USPQ2d at 1371; *In re Fat Boys Water Sports LLC*, 118 USPQ2d 1511, 1516 (TTAB 2016); *In re Cannon Safe, Inc.*, 116 USPQ2d 1348, 1351 (TTAB 2015). Based on the facts before us, the individual components retain their descriptive meaning in the composite term "THE ORIGINAL CHECKERBOARD CO." and, therefore, the composite term is merely descriptive.

³⁰ Applicant's Appeal Brief, 8 TTABVUE 4, 12.

Applicant argues that the USPTO has allowed registration of other well-known fabric pattern names in connection with comparable goods on the Principal Register, clearly recognizing that the marks as a whole amount to more than the sum of their individual parts. The marks below, according to Applicant, are examples of the suggestive quality of pattern names in connection with goods similar to those in Applicant’s application³¹:

Mark	Registration No.	Relevant Goods
CHECKS AND STRIPES	5763041	Tops as clothing; Bottoms as clothing; Headwear in Class 25
BLACK STRIPE CLOTHING COMPANY CLOTHING COMPANY disclaimed	5756097	Hats; Hoodies; Shirts; Sweatshirts; T-shirts; Hooded sweatshirts in Class 25
DOT & STRIPE	5909260	Blazers; Blouses; Coats; Dresses; Jackets; Pants; Shirts; Shorts; Skirts; Tops as clothing in Class 25
STITCHES AND STRIPES	5354896	Clothing, namely, sweaters, dresses, skirts, cardigans, pants, tunics, beanies, scarves in Class 25
13 STRIPES	5577195	Hats, shirts in Class 25
STRIPES AND SOLIDS	2583700	Clothing namely, T-shirts, shorts, shirts, pants, socks, jackets, sweaters, caps, shoes, boots, pajamas, scarves, robes, underwear, bathing suits, gloves and ear muffs in Class 25
RED PLAID SOCIETY	4716163	Clothing, namely, tee shirts and caps in Class 25

³¹ See evidence submitted with May 14, 2020 Response to Office Action at TSDR 9-49.

<p>Paisley & Gray</p>	<p>5767281</p>	<p>Men's suits; suit separates, namely, jackets, pants, and vests; blazers; pants; shorts; shirts; ties as clothing; knits, namely, sweaters and jackets; outerwear, namely, overcoats; footwear in Class 25</p>
<p>RED STRIPE</p>	<p>1744634</p>	<p>Clothing; namely, shirts and visors in Class 25</p>
<p>STARS STRIPES AND SOLIDS</p>	<p>2683363</p>	<p>Clothing namely, T-shirts, shorts, shirts, aprons, bath robes, pants, socks, jackets, sweaters, caps, shoes, boots, pajamas, scarves, robes, underwear, bathing suits, hats, gloves and ear muffs in Class 25</p>
<p>  INDIGO and PAISLEY disclaimed </p>	<p>5988602</p>	<p>Beach coverups; Blouses; Caftans; Dresses; Jackets; Jumpsuits; Pants; Pareos; Rompers; Sarongs; Scarves; Shirts; Short-sleeved shirts; Shorts; Sleepwear; Tank tops; Tunics; Clothing, namely, wrap-arounds in Class 25</p>

Applicant contends that the marks covered in the foregoing registrations support its position that “consumers will immediately perceive THE ORIGINAL CHECKERBOARD CO., not as a descriptor of the patterns on [its] goods, but as a playful, unitary phrase that suggestively references the concepts at the heart of Applicant’s brand, namely, the thrills and excitement associated with action sports and skate culture,” concluding that “THE ORIGINAL CHECKERBOARD CO.” is “a unitary and playfully suggestive phrase that consumers will perceive as referring to

Applicant's carefully crafted brand identity. It does not immediately convey to consumers qualities or characteristics of Applicant's clothing goods."³²

While the Board must decide each case on its own merits, even if the cited registrations have some characteristics similar to Applicant's mark, the USPTO's allowance of such prior registrations does not bind the Board. *In re Nett Designs Inc.*, 236 F.3d 1338, 57 USPQ2d 1564, 1566 (Fed. Cir. 2001). More importantly, none of the third-party registrations cited by Applicant are similar to the applied-for mark inasmuch as they contain different wording and wording structures than those used in Applicant's mark.³³ In view of the different natures of Applicant's mark and the marks in the cited third-party registrations, they provide no support for the registrability of Applicant's mark on the Principal Register.

Here, the combination of the descriptive or non-source indicating terms comprising Applicant's mark does not create a unitary mark with a separate, nondescriptive meaning. The wording "THE ORIGINAL CHECKERBOARD CO." directly conveys information about Applicant's goods. No amount of imagination, thought, or perception is needed to understand that Applicant's goods feature a checkerboard design.³⁴ The evidence establishes that the average consumer would be accustomed to seeing these terms used to refer specifically to features of clothing, footwear and headwear. Accordingly, for the reasons set forth above, Applicant's

³² Applicant's Appeal Brief, 8 TTABVUE 12.

³³ Examining Attorney's Brief, 10 TTABVUE 10.

³⁴ See Applicant's specimen at TSDR 1-21; Applicant's Appeal Brief, 8 TTABVUE 12; Applicant's Reply Brief, 11 TTABVUE 3-4.

applied-for mark is merely descriptive of a feature or characteristic of such goods under § 2(e)(1) of the Trademark Act.

In the alternative, Applicant seeks registration on the Supplemental Register.³⁵ If, in an application that is the subject of an ex parte appeal to the Board, the applicant has asserted alternative positions (such as, that its mark is not merely descriptive of its goods and/or services, and that the mark has, in any event, become distinctive of its goods and/or services in commerce; or that its mark has become distinctive of its goods and/or services in commerce, and that the mark is, in any event, registrable on the Supplemental Register), the examining attorney should clearly state their position with respect to each of the applicant's alternative claims. TRADEMARK TRIAL AND APPEAL BOARD MANUAL OF PROCEDURE ("TBMP") § 1215 (2021). As noted by the Examining Attorney in her brief, "[a]s stated in previous Office actions, the applied-for mark is eligible for registration on the Supplemental Register with a disclaimer of 'CO. ESTABLISHED SINCE SIXTY-SIX'."³⁶ Thus, Applicant has been advised that its application is eligible for registration on the Supplemental Register subject to entry of the disclaimer of "CO. ESTABLISHED SINCE SIXTY-SIX" as this wording is generic or incapable of registration in the context of Applicant's goods. Therefore, Applicant will be given time to file the disclaimer upon which its application will proceed to the Supplemental Register.

³⁵ Request for Reconsideration at TSDR 10.

³⁶ Examining Attorney's Brief at 10 TTABVUE 20; January 13, 2020 Office Action at TSDR 5; June 9, 2020 Final Office Action at TSDR 4.

Decision: The refusal to register THE ORIGINAL CHECKERBOARD CO. ESTABLISHED SINCE SIXTY-SIX on the Principal Register under § 2(e)(1) of the Trademark Act is affirmed.

Applicant's request, in the alternative, for registration on the Supplemental Register will be granted upon Applicant's submission of a disclaimer of "CO. ESTABLISHED SINCE SIXTY-SIX" to the Board within thirty days from the date of this decision. The disclaimer should read: "No claim is made to the exclusive right to use 'CO. ESTABLISHED SINCE SIXTY-SIX' apart from the mark as shown." Registration of the mark on the Supplemental Register is refused in the absence of such disclaimer.